

REMARKS

Claims 1-25 are pending in the present application. Independent claims 1, 8, and 18 have been amended without introducing any new subject matter. By this amendment, independent claims 1 and 18 have been amended to include “determining if an authorization signal has been received from the base station at the user terminal within a specified period of time for the transmission of the authorization signal.” Likewise, claim 8 has been amended to include “determining if an authorization signal has been received from the base station at the device within a specified period of time for the transmission of the authorization signal.” Support for this amendment may be found throughout the Applicants’ Specification, for example, on page 13, lines 17-23. Applicants respectfully traverse the Examiner’s rejections of claims 1-25 in view of the remarks set forth below.

In the Office Action, claims 1-8, 10-16 and 18-24 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Number 6,556,818 to Meehan (hereinafter *Meehan*). An anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *Meehan* does not teach or suggest receiving an authorization signal from the base station at the user terminal (device) within a specified period of time. Instead, *Meehan* evaluates the response of the caller during a set time-out period in a wireless carrier network that provides pre-paid calling party pays (CPP) services for land line customers, in col., 13, lines 55-60, as cited by the Examiner. *Meehan* is completely silent with respect to the determining feature in which an authorization signal is received from the base station. However, as amended, independent claims 1, 8, and 18, among other things, include this determining feature for authorizing a user terminal to communicate with a base station in a communication system before transmitting information to the base station

from the user terminal. Based on the above-indicated legal standard, it is respectfully submitted that *Meehan* fails to anticipate claims 1, 8, and 18. Thus, claims 1-8, 10-16 and 18-24 are in condition for allowance which is respectfully requested of the Examiner.

In particular, independent claim 1 sets forth, among other things, determining if an authorization signal has been received from the base station at the user terminal within a specified period of time for the transmission of the authorization signal. If the authorization signal is not received from the base station within the specified period of time at the user terminal, the transmitter of the user terminal may be disabled. According to one illustrative embodiment of the present invention, the Applicants' Specification describes that a base station 120 periodically transmits an "authorized to transmit" signal (AT signal) to the user terminal 110. The AT signal authorizes the user terminal 110 to communicate with the base station 120. The AT signal may be used to prevent the user terminal 110 from transmitting provided that the radio communication system 100 deems that the user terminal's communication in the system 100 is unauthorized or otherwise communicating in an improper manner. See Applicants' Specification on page 13, lines 17-23. For example, if the authorization signal is not received from the base station 120, the user terminal 110 may be prevented from transmitting messages to the base station 120. That is, the transmitter 220 may be disabled. See Applicants' Specification on page 15, lines 2-5.

Rather than determining if an authorization signal has been received from the base station 120 at the user terminal 110 within a specified period of time for the transmission of the authorization signal, *Meehan* determines if a response from a caller is received during a set time-out period at the mobile subscriber terminal, or hand-set, or station 11. Based on the nature of the response, such as a valid PIN entry, the call is routed to an appropriate mobile switching

center (MSC) and to the destination mobile station for completion of the call. See *Meehan*, col. 13, lines 61- col. 14, line 2. In this way, communication between mobile subscriber terminals 11 at different base stations can be completed through a wireless network path between base stations 13 and the MSC 15, as shown in Figure 1 of the cited reference. *Meehan* determines whether a call process record (CPR) for the calling subscriber station indicates subscription to service billing coverage for out-going calling party pays (CPP) calls from the calling subscriber station. In response to a CPP billing coverage subscription determination, a signaling message is transmitted to the mobile switching center (MSC) connected to the base stations. The call may be routed through the MSC for completion to the called mobile station. See *Meehan*, col. 14, lines 29-42.

However, amended claim 1 sets forth, among other things, determining if an authorization signal has been received from the base station at the user terminal within a specified period of time for the transmission of the authorization signal. As described above, *Meehan* is completely silent with regard to this determining feature. For at least this reason, independent claims 1, 8, and 18 are in condition for allowance since *Meehan* fails to disclose or suggest all the limitations in the amended claims.

The Examiner asserts that *Meehan* teaches the determining feature in col. 13, lines 55-⁶³ col. 14, line 2. In contrast, *Meehan* determines application of air time charges either for a mobile customer based on a response from a caller for processing a call placed from a subscriber station to a mobile station of a calling party pays, (CPP) service subscriber or to the mobile station of the calling party. Accordingly, Applicants' respectfully submit that in *Meehan*, a determination of routing the call through the MSC for completion of the call is made for accounting for air-time charges based on a response of the caller during a set time-out period.

This response of the caller within a set time-out period is not related to the way an authorization signal is received from the base station at the user terminal within a specified period of time for the transmission of the authorization signal.

For at least the aforementioned reasons, Applicants' respectfully submit that the present invention is not anticipated by *Meehan* and request that the Examiner's rejections of claims 1-8, 10-16 and 18-24 under 35 U.S.C. § 102(e) be withdrawn.

Claims 9 and 25 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Meehan* in view of *Lambert* (U.S. Patent No. 5,642,380). Additionally, claim 17 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Meehan* in view of *Newton's* Telecom Dictionary. Applicants' respectfully traverse the Examiner's rejections of claims 9, 17 and 25. As to the rejection of claim 9, the Examiners alleges *Meehan* teaches means for determining and disabling. However, the Examiner concedes that *Meehan* does not teach that the device comprises a modem having a software component with software running thereon and a hardware component that includes the signal detector, transmitter, controller and means for determining the means for disabling. To provide a teaching for this missing feature, the Examiner relies on *Lambert*. The Examiner asserts that *Lambert* teaches a modem having a software component with software running thereon and a hardware component that includes the signal detector, transmitter, and controller. See *Lambert*, col. 6, lines 8-26.

The Examiner concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified *Meehan* so that the radio telephones would have included a modem, as set forth in claim 9. The rationale to modify

Meehan by the teaching of *Lambert* is indicated to be an advantage when a channel is to be shared with signals intended for human listening. See *Lambert*, col. 6, lines 8-26.

M.P.E.P. in § 2143 requires that the teaching or suggestion to combine references must be found within the prior art, not in the Applicant's disclosure. This section states that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The section 2143 further notes that a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references.

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of hindsight reconstruction using the Applicants' specification) to make the necessary changes in the disclosed device or method. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. App. 1985); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner has failed to show or cite where in *Meehan* or *Lambert* there exists a reasonable expectation of success if the reference teachings are combined, as required by § 2143 of the M.P.E.P. In fact, the Examiner is silent as to this requirement for making out a *prima facie* case of obviousness.

There is no statement or inference in *Meehan* or *Lambert* that would suggest that the references could be successfully combined. The disclosures of these references are considerably different. *Meehan* is directed to a wireless carrier network that provides pre-paid calling party pays (CPP) services for land line customers of a wireless telephone network, such as cellular or personal communication service (PCS) customers, and *Lambert* discloses a modem with a variable symbol rate for transmission and reception of digital data signals in a digital communication system.

The references simply were not intended to be modified or combined as suggested by the Examiner. Even if the proposed combination occurred, it would still be unable perform the claimed features of the present invention. Furthermore, if there is no motivation to combine found in the references, clearly then, the references cannot show or even implicate a reasonable expectation of success, which is required to make out a *prima facie* case of obviousness. Therefore, for at least this reason, Applicants respectfully request that the rejection of dependent claims 9 and 25 be withdrawn and the claims be allowed.

As to claim 17, *Meehan* does not teach that the device and the base station communicate with each other in accordance with a Global system for Mobile Communications (GSM) protocol. However, according to the Examiner, *Newton* teaches the Global system for Mobile Communications (GSM) protocol and its benefits [page 350]. Hence, the Examiner concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify *Meehan* so that the radio telephone can communicate with the base station/control station using the Global system for Mobile Communications (GSM) protocol. The Examiner alleges that motivation is there since GSM ensures interoperability

between countries, these ETSI standards address much of the network wireless infrastructure, including the radio interface (900 MHz), switching, signaling and intelligent network [page 350].

Applicants also submit that claim 17 is not rendered obvious over *Meehan* in view of *Newton's* Telecom Dictionary. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As discussed above, *Meehan* fails to teach or suggest the determining feature based on an authorization signal received from a base station at a user terminal. The Examiner relies upon *Newton's* Telecom Dictionary to describe a Global System for Mobile communications (GSM) protocol. However, this reference does not remedy the fundamental deficiencies of the primary reference.

As the Examiner well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

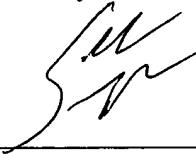


With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

For at least the aforementioned reasons, Applicants' respectfully submit that the present invention is not obvious over the cited references, either alone or in combination. Applicants request that the Examiner's rejections of claims 9, 17, and 25 under 35 U.S.C. 103(a) be withdrawn. Accordingly, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4089 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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AGENT FOR APPLICANTS

IN THE DRAWINGS

Applicants acknowledge that the Examiner has accepted the drawings filed on July 9, 2001.